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PATENT

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

ELECTION

In Re Application of:

Sanghvi, et al.

Confirmation No.: 3043

Serial No.: 09/640,279

Group Art Unit: 1635

Filed: August 16, 2000

Examiner: J. Epps

For: PROCESSES FOR THE PREPARATION OF OLIGONUCLEOTIDES

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DATE OF DEPOSIT July 24, 2002

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RESPONSE TO RESTRICTION

This is in response to the Restriction Requirement dated July 12, 2002 in connection with the above-referenced patent application. The Office Action requires restriction to one of six claimed inventions, parsed into the following groups:

Group I: Claims 1-41, drawn to a method for preparing an oligonucleotide compound, wherein said compound comprises an X2 group that is O, wherein said method comprises treating an extended compound with a mixture comprising an oxidizing reagent and a capping reagent in one step, classified in class 536, subclass 22.1.

Group II: Claims 1-41, drawn to a method for preparing an oligonucleotide compound, wherein said compound comprises an X2 group that is S, wherein said method comprises treating an extended compound with a mixture comprising an oxidizing reagent and a capping reagent in one step, classified in class 536, subclass 22.1.

Group III: Claims 42-61, drawn to a method for preparing an oligomeric compound, wherein said method comprises treating an extended compound with dimethylthiuram disulfide in a step separate from the capping step, classified in class 536, subclass 22.1.

Group IV: Claim 62, drawn to a method of preparing an oligomeric compound wherein X2 is O, and wherein at least one set of nucleoside monomers are connected via the 2' and 5' positions of the ribose sugar moieties of said monomers, classified in class 536, subclass 22.1.

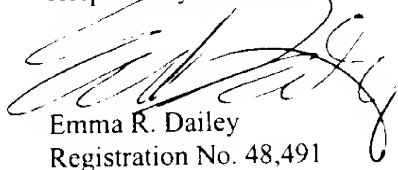
Group V: Claim 62, drawn to a method of preparing an oligomeric compound wherein X2 is S, and wherein at least one set of nucleoside monomers are connected via the 2' and 5' positions of the ribose sugar moieties of said monomers, classified in class 536, subclass 22.1.

Group VI: Claims 63-78, drawn to a synthetic process for forming a precipitate, classified in class 585, subclass 833.

In response, Applicants elect Group II (*i.e.*, claims 1-41). However, this election is made with traverse because the proposed restriction requirement is unduly limiting. Applicants respectfully submit that the Examiner has failed to demonstrate the undue burden of conducting a search that would include claims of Group I and Group II. Notably, the claims in Groups I and II fall within the *same* class and subclass (*i.e.*, Class 536 and Subclass 22.1), and differ only in that in Group I the variable X2 is O and in Group II, X2 is S. A search in the same class and subclass for two possible values for X2 could easily be conducted without undue burden. Accordingly, the reasons for restriction clearly do not support the Examiner's proposed parsing of Applicants' claims.

Applicants respectfully submit that the foregoing constitutes a *bona fide* attempt to advance prosecution. Applicants solicit an early Office Action on the merits.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'Emma R. Dailey', is written over the typed name and registration number.

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Date: **July 24, 2002**

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